

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 19-3869.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 19-3869.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

The original declaration was found to be defective, apparently because the original declaration acknowledges a duty to disclose information "material to examination" whereas 37 CFR § 1.63(b)(3) requires acknowledgement of a duty to disclose information "material to patentability." In response, Applicants submit that there is, in fact, no defect, and, therefore, a substitute declaration is not required. Although the Examiner is correct about the requirements of 37 CFR § 1.63(b)(3), there is nothing therein that requires that the exact words "material to patentability" must be used. Applicants submit that the phrase "material to examination" necessarily embraces anything "material to patentability" since the object of examination is to determine patentability. Consequently, although Applicants have not used the words "material to patentability," they have, in fact, acknowledged a

duty to disclose information "material to patentability" by acknowledging a duty to disclose information "material to examination."

Claims 1, 4 and 8 were objected to for their use of bullets. In response, the previous claims have been canceled in favor of a new set of claims, which does not utilize bullets.

For the Examiner's information, Applicants point out that the new claims correspond to the previous claims as follows:

| <u>New Claim</u> | <u>Previous Claim</u> |
|------------------|-----------------------|
| 12 | 1 + 2 |
| 13 and 14 | 5 |
| 15 | 6 |
| 16-18 | 7 |
| 19 and 20 | 8 |
| 21 and 22 | 9 |
| 23 | 10 |
| 24-26 | 11 |

Claims 1, 2 and 4-11 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,725,844. In response, Applicants point out that the present claims require "k" is 2 to 8, which means that component b) must be a polyglyceryl compound. Applicants do not believe that polyglyceryl compounds are disclosed in U.S. Patent No. 5,725,844. Accordingly, the instant claims are not obvious from this patent alone, and thus their cannot be obviousness-type double patenting.

Claims 1, 2 and 4-11 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants submit that the new claims are free of each of the Examiner's concerns. Thus, proper Markush language is employed throughout the new claims. Also, the preferred embodiments of the previous claims have been made the subject of dependent claims. Finally, the phrase "characterized in that" is not used in the new claims.

Claims 1, 2 and 5-7 were rejected under 35 USC § 102(b) as being anticipated by Grollier et al. ("Grollier"), U.S. Patent No. 5,427,771. In response, Applicants point out that the new claims require component c), i.e., a superficially hydrophobic inorganic pigment, which is not taught by Grollier. Accordingly, Grollier is not an anticipation of the present claims.

Claims 1, 2, 4, 5, 7-9 and 11 were rejected under 35 USC § 102(e) as being anticipated by Gers-Barlag et al. ("Gers-Barlag"), U.S. Patent No. 5,725,844. In response, as previously mentioned in connection with the obviousness-type double patenting rejection, Gers-Barlag does not teach instant component b), i.e., a polyglyceryl compound of the recited formula. Accordingly, Gers-Barlag is not an anticipation of the present claims.

Claims 1, 2 and 5-7 were rejected under 35 USC § 102(e) as being anticipated by Billia et al. ("Billia"), U.S. Patent No. 5,486,353. In response, Applicants point out that the new claims require component c), i.e., a superficially hydrophobic inorganic pigment, which also is not taught by Billia. Accordingly, Billia is not an anticipation



HEINRICH GERS-BARLAG ET AL.
USSN 08/987,468

of the present claims.

Claims 1, 6, 8 and 10 were rejected under 35 USC § 103(a) as being obvious over Gers-Barlag in view of Kaplan, U.S. Patent No. 5,047,232, and Grollier. In response, Applicants submit that there is nothing in Gers-Barlag or the combination thereof with Kaplan and/or Grollier to suggest that the achievement of water-resistance or increased water-resistance could be achieved in the context of O/W and W/O emulsions having the instant components a)-c).

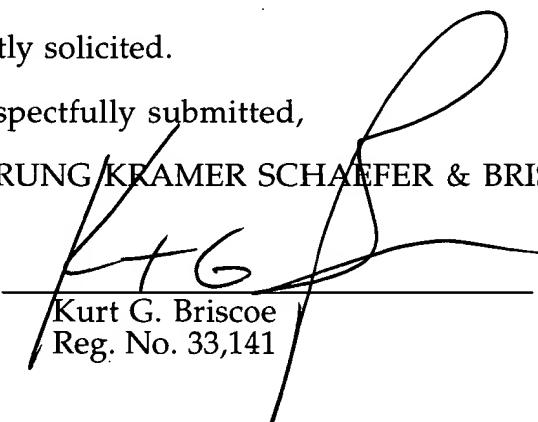
Applicants believe the foregoing constitutes a full and complete response to all outstanding objections and rejections.

Early and favorable action is earnestly solicited.

Respectfully submitted,

SPRUNG KRAMER SCHAEFER & BRISCOE

By


Kurt G. Briscoe
Reg. No. 33,141

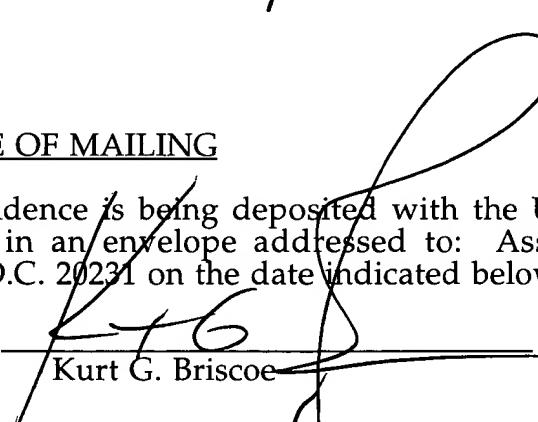
660 White Plains Road
Fourth Floor
Tarrytown, New York 10591-5144
(914) 332-1700

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date indicated below:

Date April 6, 1999

By


Kurt G. Briscoe